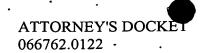## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 6, 2003. At the time of the Office Action, Claims 1-44 were pending in this patent application. The Examiner rejects Claims 1-44. Claims 1, 21, and 26 have been amended to make stylistic changes and to more clearly claim what the inventor believes to be the invention. Applicants do not admit that these amendments were made as a result of any cited art. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejection

The Examiner rejects Claims 1-13 and 19-24 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,167,383, issued to Henson ("*Henson*") in view of U.S. Patent No. 6,324,522, issued to Peterson et al. ("*Peterson*") and Official Notice. Applicants respectfully request consideration of this rejection of Claims 1-13 and 19-24 for the following reasons.

First, Applicants disagree with the Examiner's conclusion that it would have been obvious to one of ordinary skill in the art at the time of invention to combine the customized online ordering method of *Henson* with the inventory management system of *Peterson*. Applicants reiterate the standard for combining references under 35 U.S.C. § 103. Although the Examiner speculates that "it would have been obvious" to make the proposed combination to "provide a means for a manufacturer to track component availability based on the items being ordered online, and thus increase customer satisfaction by accurately indicating item availability and delivery time," Applicants submit that the modification of *Henson* to include the features of *Peterson* would impermissibly change the principle of operation disclosed in *Henson*. In fact, the very reasons given by the Examiner as providing the motivation for the combination conflict with the inventions disclosed in *Henson* and *Peterson*. *Henson* provides for the sale of not yet manufactured computers. Since all computers available through the *Henson* online system would be unavailable when the order is placed, there would be no need for the manufacturer to track availability of the items being ordered online. Conversely, a customer using the system of *Peterson* is limited to ordering items from a vendor's existing inventory. Therefore, *Henson* and *Peterson* use different methods for different purposes. For at least these reasons, it would not have been obvious to one of ordinary skill in the art at the
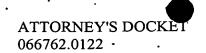
time of invention, to combine the online order system of *Henson* with the inventory management system of *Peterson*.

Second, to defeat a patent under 35 U.S.C. § 103, the prior art references "must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicants' disclosure." *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 706.02(j). Assuming only for purposes of argument that the references may be combined, the *Henson-Peterson* combination does not disclose, either expressly or inherently, each and every element of the claims.

Regarding Applicants' independent Claim 1, Applicants respectfully submit that neither *Henson* nor *Peterson* discloses, teaches, or suggests "wherein the custom order is cancellable after processing of the custom order is initiated and until the custom order is scheduled for manufacturing," as recited in amended Claim 1. As discussed above, *Henson* merely discloses a method for configuring a computer by a customer. *Peterson* also does not disclose, teach, or suggest the above-recited features and operation. To the contrary, *Peterson* teaches away from this limitation. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); MPEP § 2414.02.
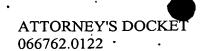
Peterson discloses and describes an order entry process. (Column 22, line 50 through Column 27, line 6). Distinct from the order entry process, *Peterson* also discloses and describes a requisition entry process. (Column 30, line 50 through Column 34, line 56). In rejecting Claim 1, the Examiner erroneously equates the "requisition" of *Peterson* with Applicants' claimed "order." In addition to describing the order entry process and requisition entry process separately, *Peterson* explicitly discloses that "the requisition processes and tables, while similar to orders and quotes have some differences. The information supplied to the detail and header tables in the vendor's database is supplied by customers. The vendors do not update this information and in many cases do not know this information exists. Also, the information created within the requisition cycle creates, modifies, and deletes database table records." (Column 34, lines 49-56). Accordingly, *Peterson* specifically distinguishes between an order and a requisition.

With regard to requisitions, *Peterson* discloses an entry process, a status process, and an approve process. While creating a requisition form, "a user scrolls (if necessary) through the displayed list until the user finds the item that the user wishes to buy. Once the user has located the item, the user clicks on the 'Choose This Item' button to select the item." (Column 32, lines 51-54). Although the user can cancel the requisition, "the user can only cancel a requisition that the user is creating. In other words, the user can not cancel a requisition that has already been submitted while in the requisition entry application." (Column 34, lines 22-26).

Whereas the Requisition Status function lets the user review requisitions that the user has previously placed on the information network such that "all requisitions can be viewed, edited, or deleted," *Peterson* further provides that "[w]hen a requisition is created, it does not get sent to the vendor until it is converted into an order by the Approve Requisition function." (Column 39, lines 12-19). Thus, *Peterson* merely discloses that a user may delete or edit requisitions until the requisition is approved. "If the user (as identified by the ID supplied during the log-on step 104) is an individual authorized to approve requisitions, the option to approve requisitions is displayed [to the user]." (Column 40, lines 20-25). "The user can turn the requisition into an order by actuating a 'Convert Requisition To Order' control . . . [T]he requisition data is captured, and the user is linked to the Order Form page . . .There, the data is pulled into the order entry logic for final data input. " (Column 41, lines 13-19). Accordingly, the portion of *Peterson* relied on by the Examiner to reject Claim 1 merely discloses that a user may delete or edit a requisition until it is converted into an order.

Once the order is placed, "[t]he Order Status function on the information network lets the user review orders that the user has previously placed with the user's vendors. The orders are grouped into three categories: New Orders, Orders in Process, and Processed Orders." (Column 34, lines 59-63). "Unlike the Orders to be Processed and the Processed Orders sections, the New Orders section provides control buttons to enable editing or deleting a new order. The user can only edit or delete an order if the order has not begun to be processed by the user's vendor." In teaching that Orders in Process and Processed Orders cannot be edited or deleted, *Peterson* actually teaches away from the features recited in Applicants' Claim 1. For at least these reasons, neither *Henson* nor *Peterson* can be said to disclose, teach, or suggest "wherein the custom order is cancellable after processing of the custom order is

initiated and until the custom order is scheduled for manufacturing," as recited in Applicants' Claim 1. These features are completely absent from *Henson* and *Peterson*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1, together with dependent Claims 2-13 and 19-20 that depend from Claim 1.

For similar reasons, the *Henson-Peterson* combination does not disclose, teach, or suggest "an order bank operable to store the online order and schedule a product having the product configuration specified in the online order for manufacturing, wherein the custom order is cancellable after processing of the custom order is initiated and until the custom order is scheduled for manufacturing," as recited in Applicants' Claim 21. As described above, *Henson* is limited to nothing more than a method for configuring a custom computer by a customer. Further, in teaching that a requisition cannot be cancelled after it has been approved and in teaching that orders to be processed and processed orders cannot be cancelled, *Peterson* actually teaches away from the features recited in Applicants' Claim 21. Again, the recited features are completely absent from *Henson* and *Peterson*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 21, together with dependent Claims 22-24 that depend from Claim 21.

The Examiner rejects Claims 13-18 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of *Peterson* and in further view of U.S. Patent No 5,231,267, issued to Matoba et al. (*"Matoba"*). Applicants respectfully request reconsideration of this rejection of Claims 13-18.

First, Applicants have shown above that the *Henson-Peterson* combination does not recite each and every claim limitation of Claim 1, from which Claims 13-18 depend. Thus, Claims 13-18 are allowable for at least this reason.

Second, Applicants respectfully submit that in rejecting Claims 13-18 the Examiner has improperly performed what amounts to a "keyword rejection." Applicants traverse the Examiner's rejection at least because it appears that the Examiner simply performed a keyword search to locate the word "lead" in the text of *Matoba* and then uses this word to reject those portions of Claims 13-18 that happen to also include the word "lead." Significantly, however, the keywords are often taken out of context and do not teach, suggest, or disclose the claimed aspects of the present invention.

As acknowledged by the Examiner (Office Action, page 9), "lead" as disclosed in *Matoba* refers to "lead time," i.e., "the number of days estimated as demanded for completion of a product to be manufactured." (Background) Specifically, *Matoba* discloses a system "capable of automatically determining a lead time in consideration of product specifications, appointed date of delivery and production process states and capable of creating a production schedule on a basis of the lead time in an automated manner." (Column 1, line 64 through Column 2, line 3). An examination of the teachings of *Matoba* confirms that *Matoba* cannot be said to disclose, teach, or suggest "a lead request message incorporating lead data and product configuration data submitted by the user, the lead data identifying the online user as a potential customer," as recited by Applicants' amended Claim 13. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 13-18.

The Examiner rejects Claims 25-44 under 35 U.S.C. § 103(a) as being unpatentable over *Henson* in view of *Peterson* and *Matoba*, and further in view of U.S. Patent No. 6,041,310, issued to Green et al. (*"Green"*). Applicants respectfully request reconsideration of this rejection of Claims 25-44.

Regarding Independent Claim 26, Applicants respectfully traverse the Examiner's position. Claim 26 recites, in part, "receiving a custom order message . . . submitted by an online user . . . entering the custom order and its associated data into an order bank to schedule the specified vehicle for manufacturing, wherein the custom order is cancellable after processing of the custom order is initiated and until the specified vehicle is scheduled for manufacturing . . . generating an order confirmation message and sending the order confirmation message to the user." Nowhere does the *Henson-Peterson-Matoba-Green* combination disclose, teach, or suggest these aspects of the claimed invention.

For reasons similar to those above with regard to Claim 1, the system of *Henson* does not disclose the features and operation recited in Applicants' Claim 26. To the contrary, *Henson* merely discloses a method for configuring a custom computer by a customer, which does not include the processing of the order after submission. Thus, the recited features are completely absent from the online store disclosed in *Henson*. In teaching that a requisition cannot be cancelled after it has been approved and in teaching that Orders in Process and Processed Orders cannot be cancelled, *Peterson* actually teaches away from the features recited in Applicants' Claim 26. Because this deficiency is not cured by either *Matoba* or

Green, the combination of references cannot be said to disclose, teach, or suggest "wherein the custom order is cancellable until the specified vehicle is scheduled for manufacturing," as recited in Applicants' Claim 26.

For at least these reasons, and for those stated above with respect to Claim 1, Applicants respectfully request reconsideration and allowance of Claim 26. Claim 25 depends from Claim 21 shown above to be allowable. Claims 27-44 depend from Claim 26 shown above to be allowable. Regarding Claims 38-42, Applicants respectfully submit that the Examiner has improperly performed what amounts to a "keyword rejection." For reasons, similar to those discussed above with regard to Claims 13-18, the Examiner has taken the word "lead" as discussed in *Matoba* out of context and has improperly used *Matoba* to reject Applicants' claimed "lead data." For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 25-44.

CONCLUSION

Applicants appreciate the Examiner's efforts to review this case. Applicants' prior response attempted to clarify the patentable aspects of the claimed invention. This response is necessary to further clarify the patentable aspects of the claimed invention and to distinguish the claimed invention from the Examiner's perception of the scope of the cited references. This response was not earlier presented, and is therefore presented herein, due to the realization that the patentable aspects of the claimed invention presented earlier have not been specifically appreciated by the Examiner in order to attain a clear understanding of the claimed invention.

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicants, at the Examiner's convenience at (214) 953-6581.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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Date: _April 4_, 2003

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